Appln. No. 09/751,801
Amendment dated April 26, 2004
Reply to Office Action mailed January 26, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 37 remain in this application. No claims have been cancelled, withdrawn, or added.

Claims 1 through 37 have been rejected under 35 U.S.C. §102(e) as being anticipated by Treyz et al (U.S. 6,526,335) (hereinafter "Treyz").

While it is noted that it may be possible for the applicant to swear behind the Treyz patent based upon its filing date, the §102 rejection is being traversed on the basis that it does not anticipate the claimed invention, although applicant reserves the right to present evidence of prior invention at a later time should the rejection be maintained.

Claim 1 requires "storing acceptance data in the communication device", "receiving by the communication device a broadcast advertisement containing advertisement data", and "comparing the advertisement data to the acceptance data to obtain a comparison result". It is alleged in the Office Action that the Treyz patent anticipates the requirements of claim 1, however, it is submitted that Treyz discusses the filtering of content based upon the "interests" and the "location" of the user, not base upon acceptance data, and it suggests that the filtering occurs at a remote server, and not at the communication device. See, in particular, the Treyz patent at col. 60, lines 16 through 25 and lines 46 through 67 (emphasis added):

> At step 852, the automobile personal computer 14 may deliver content to the user based on the user's interests as determined at step 850. The content that is presented at step 852 may be filtered from broadcast content, may be locally-generated content, may be provided from a remote server (e.g., on request from the automobile personal computer), may be provided from a message or other targeted content that is distributed from the remote server to the user based on information on the user's interests that was previously forwarded to the remote server, etc.

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* * *

Targeted information may be presented to the user based on the automobile's location. Illustrative steps involved in presenting information to the user based on location information are shown in FIG. 73. At step 868, automobile personal computer 14 may be used to determine the user's interests (as at step 850 of FIG. 72). At step 870, the location of automobile 12 may be determined (e.g., automobile personal computer 14 may be used to determine the location of automobile 12). The location of automobile 12 may be determined using GPS receiver 112 or any other suitable location-determining arrangement. The projected location of automobile 12 may be determined from GPS heading data or from destination information provided by the user or using any other suitable approach. At step 872, a local database at automobile 12 or a remote wireless link to a remote database may be used to provide the user with access to information on restaurants, hotels, and other merchants and services that are in the vicinity of the present or projected location of automobile 12. For example, automobile personal computer 14 may provide the user with an audio or visual list of matching merchants and may provide the user with an opportunity to contact these merchants.

It is submitted that, rather than storing and comparing a user's "acceptance data" indicating what broadcast advertisements the user will accept, the Treyz patent leads one of ordinary skill in the art to collecting information about the user's interests and location, and using that information at a remote server to filter content before it is transmitted to the communication device of the user. It is therefore submitted that the Treyz patent would not lead one of ordinary skill in the art to the invention as required by claim 1.

With respect to claim 4, which requires "wherein the broadcast advertisement is received by the communication device from one of: a billboard and a storefront", it is contended in the Office Action that this feature of the invention is anticipated by the Treyz patent at col. 57, lines 31 through 59, which states (emphasis added):

Automobile personal computer 14 may also be used to facilitate other types of purchase transactions. Illustrative steps involved in one such type of purchase transaction are shown in FIG. 68. At step 860, automobile personal computer 14 may be used to provide the user with an opportunity to make a financial commitment toward purchasing a

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product or service (e.g., food, gas, lodging, etc.). The user need not
make a particular bid. For example, the user may be approaching a city
in which the user is planning to seek lodging. The user may commit 25
dollars toward the evening's lodging bill (minus a transaction fee if
desired). The commitment may be backed, for example, by a credit
card. The user may agree to forfeit the that amount the user has
committed (i.e., $25) if the user declines to stay in any of the hotels
that are offered.

A server (e.g., a remote server accessed by automobile personal
computer 14 over a remote wireless link) may be used to make the
user's desire to purchase a product or service (e.g., the lodging) known
to merchants at step 862. This serves to match users who have made
financial commitments with, for example, hotels and motels in the
user's selected city who are willing to offer lodging. Hotels and motels
(and other merchants) may be willing to offer discounts because they
are assured that if the user does not select their services, the user is
very likely to select the services of a competitor (as evidenced by the
$25 commitment made by the user). The $25 commitment made by the
user may be applied toward the user's purchase.

and also by the Treyz patent at col. 84, line 54 through col. 85, line 19,

which states (emphasis added):

Messages such as advertisements and notifications or any other
suitable material may also be provided using e-mail or the like. For
example, when an automobile is sold to a user, the dealer (e.g., dealer
1138 of FIG. 110) or manufacturer (e.g., manufacturer 1150 of FIG.
11) or the user may notify a service provider (e.g., service provider
1140). After a certain time has elapsed from the date of sale (e.g., six
months), the service provider, dealer, or manufacturer may send a
message (e.g., in an e-mail format or any other suitable format) to the
user's automobile personal computer or home e-mail address as a
reminder that recommended service is due. Messages may be sent to
the user's automobile personal computer using a remote wireless link
(e.g., an Internet link or the like) or using any other suitable data
path. Messages sent from the service provider, dealer, or manufacturer
may include text, graphics, audio, and video. They may be
automatically played through the automobile's sound system and
displayed on the displays of automobile personal computer 14 when
they are received or at some time after they are received, or they may
be displayed in a list of incoming e-mail messages or the like. The
messages may include interactive content. The interactive content may
allow the user to purchase products or services, schedule service
visits, request information, etc. Remote or local wireless
communications links may be used to initiate and consummate such

transactions. The messages may be informative or commercial (e.g., advertisements) or may include a combination of such content. Any suitable condition or set of conditions may be used to trigger the distribution of such messages to the user by the service provider, dealer, or manufacturer. For example, messages may be sent when a certain time has elapsed since the sale of the automobile or since the user's last service visit.

Clearly, as indicated by the emphasized portions of these excerpts from the Treyz patent that are relied upon in rejecting claim 4, the communications being described here are not "broadcast advertisements". In the first excerpt, the user uses a server "to make known the user's desire to purchase a product or service". Thus, contrary to receiving a "broadcast advertisement" from a "billboard" or a "storefront" as required by applicants' claims 1 and 4, Treyz here discusses a situation where the user's personal computer initiates contact with a server and requests information about a product or service, and is not receiving or responding to any broadcast advertisement. Thus, rather than receiving a broadcast advertisement from a "billboard" or a "storefront", the Treyz patent here describes a situation where the user's personal computer actively seeks specific information about a particular product or service that the user needs, for example lodging as he or she approaches a town.

In the second excerpt for the Treyz patent, the "service provider" contacts the user directly based upon the automobile driven by the user, and this contact is not broadcast to many users but a message sent to the one user based upon the automobile that he or she has purchased, and the time since purchase. Further, it is clear that there is no "filtering" of the contact by the user's personal computer, and that the criteria for sending the contact are determined solely by the service provider.

Therefore, it is submitted that the Treyz patent does not anticipate the requirements of claim 4.

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Turning to claim 5, which requires that "the acceptance data comprises preferences for accepting broadcast advertisements specified by a user of the communication device", the Office Action includes the assertion that this requirement is taught by the Treyz patent at col. 3, lines 2 through 15:

> Toll collection functions may be provided using the automobile personal computer. The automobile personal computer may also be used to open garage doors.
>
> The automobile personal computer may generate expense reports based on information the automobile personal computer may gather on payments that have been wirelessly made on parking, gas, tolls, lodging, and food.
>
> The automobile personal computer may be used to assist the user in handling shopping lists. For example, shopping lists may be transferred from the home to the automobile and to a store.
>
> Filtered traffic reports may be provided using location information. Information may be gathered on how the user accesses material with the automobile personal computer, how material is presented to the user, and how the user responds to the material. Targeted content such as targeted advertisements may be provided to the user. The targeted content may be based on a user's interests and location information.

It is submitted that nothing in the above-quoted portion of the Treyz patent indicates any "acceptance data compris[ing] *preferences for accepting broadcast advertisements* specified by a user of the communication device". In contrast, each of the examples set forth in the quoted text are representative of factors that may be used to "filter" information, but do not lead one to preferences for accepting broadcast advertisements that are specified by the user. The distinction may seem slight but it is significant. For example, simply because a user may use long distance telephone services does not mean that he or she automatically prefers to receive solicitations regarding long distance telephone offers. Similarly, just because a user has made a shopping list does not mean that the user wants to receive broadcast advertisements about sales on groceries. Therefore, it is submitted that merely because the user has indicated an interest in some

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subject or visited some particular area does not necessarily mean that he or she automatically welcomes information (whether it be "targeted" or not) on that subject. The claimed invention permits the user to specify his or her preferences for accepting (or rejecting) broadcast advertisements that may be received by the communication device.

> Further, Treyz states at col. 28, lines 38 through 43 that:
>
> The information for region 406 may be obtained, for example, from an Internet service or the like. Suitable information for region 406 may include weather, news, stock quotes, or any other suitable information. If desired, the information that is displayed in region 402 may be personalized for the user.

Again, it is submitted that the Treyz patent, including this portion of Treyz, does not indicate to one of ordinary skill in the art any specifying by the user of any preferences for accepting broadcast advertisements. Similarly, at col. 59, line 31 through col. 60, line 67 and continuing on to col. 61, lines 1 through 45, the Treyz patent focuses on the user's interests, without mention of preferences that may be applied to broadcast advertising received by the communication device. Moreover, the distinction between what a user's "interests" might be, and what types of broadcast advertising the user actually wants to be exposed to through his or her communication device, can be significant, as the examples set forth above illustrate.

It is therefore submitted that claim 5, as well as claims 14, 22, 33, and 36, which include similar requirements, are not anticipated by the Treyz patent.

With respect to claim 6, which requires "modifying the acceptance data by integrating entries from a personal information manager", it is asserted in the Office Action that the Treyz patent anticipates this requirement by the discussion at col. 60, line 7 through col. 61, line 45. However, it is submitted that the portion of Treyz referenced in this rejection does not describe anything about modifying or taking acceptance

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data from a personal information manager, but instead describes active entry of information by the user of the Treyz system, such as is described at col. 60, lines 7 through 15, which states:

> Moreover, the user may be provided with opportunities to enter preference information. For example, the user may enter information on the user's most frequent driving routes, so as to be able to receive targeted traffic reports. This is merely an example. The user may supply information on any of the user's preferences if desired. If the user does not want to divulge the information that automobile personal computer collects, the user may fully or partially disable the monitoring functions. For example, the user may turn off location-based tracking.

It is submitted that this text of the Treyz patent, as well as the rest of the referenced portion of the patent, does not describe or suggest that any acceptance data is *modified* by *integrating entries* from a *personal information manager*. It appears that Treyz relies upon direct entry of preference information into the system by the user, and although the patent hints that the locations to which the user drives, the radio stations to which the user listens, and the speeds at which the user drives may be monitored, it is submitted that even these sources of information do not anticipate the requirement of "modifying the acceptance data by integrating entries from a personal information manager" as set forth in claim 6. It is submitted that the above is also pertinent to claims 17 and 23 of the present application.

In connection with claim 8, which requires "storing the broadcast advertisement on the communication device based on the comparison result", it is contended in the Office Action that the requirements of this claim are anticipated by the Treyz patent at col. 83, lines 15 through 32, which states (emphasis added):

> If desired, a dealer, service facility, manufacturer, the user, or other suitable entity <u>may install dormant messages on the automobile personal computer</u>. Dormant messages may include text, graphics, audio, and video. They may be provided through the automobile's sound system and displayed on the displays of automobile personal computer 14. Messages may be displayed as though they are incoming

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> e-mail messages even though they may be provided from a local source
> (e.g., storage within automobile 12). The messages may include
> interactive content. The interactive content may allow the user to
> purchase products or services, schedule service visits, request
> information, etc. Remote or local wireless communications link may be
> used to initiate and consummate such transactions. The messages may
> be informative or commercial (e.g., advertisements) or may include a
> combination of such content. Any suitable act may be used to trigger
> the presentation of a dormant message. For example, messages may be
> presented upon reaching a give date, exceeding a threshold sensor
> value, etc.

This text of the Treyz patent, and especially the portion emphasized above, indicates that rather than these "dormant messages" being "broadcast advertisements" as required by claims 1 and 8, these messages are instead not broadcast or transmitted to a large audience but only to the one particular user, and are not stored on the communication device *based on the comparison result from applying the advertisement data to the acceptance data.* It is clear from Treyz that the user's computer is selected for receiving these dormant messages by "a dealer, service facility, manufacturer, the user", and not through the application of acceptance data stored on the communication device to a broadcast advertisement. It is therefore submitted that the Treyz patent does not anticipate the requirements of claim 8, as well as claim 25 that includes a similar requirement.

With regard to claim 9, which requires "reading deletion data in a stored advertisement, wherein the deletion data indicates criteria for deleting the stored advertisement" and "deleting the stored advertisement from the communication device based on the deletion data", the Office Action alleges that the Treyz patent anticipates these requirements by the drawings at Figure 107b.

However, Figure 107b of Treyz merely shows a user menu 1122 that merely lists "delete" as one of the options that the user of the Treyz system

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may actively choose. The text of the Treyz patent at col. 79, lines 16 through 34 is instructive of what the Treyz system actually does (emphasis added):

> An illustrative graphical interface 1110 that <u>the user device may present</u> is shown in FIG. 106. A list 1112 may be presented that includes information on various audio files that are stored on automobile personal computer 14. The user may drag files (e.g., using a pointing device) to region 1114. Files dragged to region 1114 may be sent by e-mail by selecting e-mail option 1116. Files may be dragged to target region 1118 to move them to the user device.
>
> Copy functions may be accessed using a drop down menu. An illustrative drop down menu 1120 is shown in FIG. 107a. <u>Menu 1120 may be accessed, for example, by pressing an appropriate button while highlighting one of the filenames in list 1112.</u> If a selected file is copy protected, a menu such as menu 1122 of FIG. 107b may be presented. In menu 1122, copy option 1124 is reduced in intensity to indicate that this function is not available for the selected file, (e.g., because a serial copy management scheme or other copy protection scheme is being used).

It is clear from this description in the Treyz patent that the functions available on the menu are initiated by the user in the manner described (i.e., by accessing a drop down menu). In contrast, claim 9 requires "reading deletion data in a stored advertisement", "wherein the deletion data indicates criteria for deleting the stored advertisement" and "deleting the stored advertisement from the communication device based on the deletion data". It is clear from the Treyz patent that the deletion contemplated therein is initiated by the user of the system, and is not initiated or controlled by any data stored in any advertisement. It is therefore submitted that the Treyz patent does not anticipate the requirements of claim 9, and withdrawal of the rejection of claim 9 is respectfully requested.

Regarding claim 10, which requires, particularly as amended, "outputting a notification signal to a user of the communication device if comparison of the advertisement data to the acceptance data is accepted", it

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is submitted that the Treyz patent, especially the portion at col. 60, lines 46 through 67, does not anticipate these requirements.

With respect to claim 11, which requires "sending an indicator signal to a source of the broadcast advertisement, wherein the indicator signal notifies the source that the communication device is within a broadcast range of the broadcast advertisement", it is alleged in the Office Action that the Treyz patent discloses this feature at col. 60, lines 46 through 67, which reads (emphasis added):

> Targeted information may be presented to the user based on the automobile's location. Illustrative steps involved in presenting information to the user based on location information are shown in FIG. 73. At step 868, automobile personal computer 14 may be used to determine the user's interests (as at step 850 of FIG. 72). At step 870, the location of automobile 12 may be determined (e.g., automobile personal computer 14 may be used to determine the location of automobile 12). The location of automobile 12 may be determined using GPS receiver 112 or any other suitable location-determining arrangement. The projected location of automobile 12 may be determined from GPS heading data or from destination information provided by the user or using any other suitable approach. At step 872, a local database at automobile 12 or a remote wireless link to a remote database may be used to provide the user with access to information on restaurants, hotels, and other merchants and services that are in the vicinity of the present or projected location of automobile 12. For example, automobile personal computer 14 may provide the user with an audio or visual list of matching merchants and may provide the user with an opportunity to contact these merchants.

It is submitted that this portion of the Treyz patent does not support the position that the Treyz system anticipates the requirements of applicants' claim 11. Here Treyz does not discuss any sending of an indicator signal to a source of a broadcast advertisement, but instead indicates that information about local "restaurants, hotels, and other merchants and services" is provided from a database maintained in the automobile or at another location. The Treyz patent does not indicate that there is any notification of a source of a broadcast advertisement that a communication device is within a broadcast range of the broadcast advertisement. Clearly, the Treyz

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system does not rely upon any such signaling, as the Treyz system may use a database that is within the automobile of the user. It is therefore submitted that the Treyz patent would not lead one of ordinary skill in the art to the requirements of claim 11, as well as claims 15, 15, 29, and 34, which include similar requirements.

It is therefore submitted that the Treyz patent does not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1 through 37, especially with the requirements set forth above, and therefore it is submitted that the claims of this application are allowable over the prior art.

Withdrawal of the §102(e) rejection of claims 1 through 37 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

LEONARD & PROEHL, Prof. L.L.C.

By _____   Date: April 26, 2004
Jeffrey A. Proehl (Reg. No. 35,987)
LEONARD & PROEHL, Prof. L.L.C.
3500 South First Avenue Circle, Suite 250
Sioux Falls, SD 57105-5807
(605)339-2028 FAX (605)336-1931